

REMARKS

This paper is filed in response to the non-final Office Action mailed May 12, 2009. Following the amendments above, claims 1-6, 8, 10-14, and 16-17 are currently pending in this application. Claims 1-6, 8, and 10-14 were rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the enablement requirement. Claims 1-6, 8, and 10-14 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-6, 8, and 10-14 were rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter.

Applicant has amended claim 1 and claim 8. Applicant has added claims 16-17. No new matter has been added by these amendments, and support for the amendments may be found in the specification, claims, and figures as originally filed.

Applicant has attached a signed Declaration of Dr. William P. Osterberg. Dr. Osterberg has a PhD in economics, and has worked as a research economist at the Federal Reserve Bank of Cleveland and as a professor of economics and finance. Thus, Dr. Osterberg is, by education and experience, skilled in the art to which the invention pertains.

Reconsideration is requested in light of the amendments above, the remarks below, and the attached Declaration.

I. 35 U.S.C. § 112, First Paragraph: Claims 1-6, 8, 10-14

Applicant respectfully traverses the rejection of claims 1-6, 8, and 10-14 under 35 U.S.C. § 112, first paragraph, for failing to comply with the enablement requirement. Specifically, the Examiner argues that the specification lacks specifics and sufficient guidance and direction to support a predictable, repeatable and concrete result. (Office Action, page 4.) This rejection is respectfully traversed.

A claim meets the requirements of § 112, first paragraph if one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. *United States v. Teletronics, Inc.* 857 F.2d 778, 785. See also MPEP 2164.01.

As indicated by the attached Declaration, paragraph 7, *inter alia*, one skilled in the art would be capable of making and/or using the invention, based on the specification, claims, and the information known in the art without undue experimentation. Thus, the claims and specification provide specific and sufficient guidance and direction to support a predictable, repeatable, and concrete result.

Applicant respectfully requests the Examiner withdraw the rejection of claims 1-6, 8, and 10-14 under § 112, first paragraph.

II. 35 U.S.C. § 112, Second Paragraph: Claims 1-6, 8, 10-14

Claims 1-6, 8, and 10-14 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

"If one skilled in the art would understand the bounds of the claim when read in light of the specification, then the claim satisfies section 112 paragraph 2." *Exxon Research & Engineering Co. v. United States*, 265 F.3d 1371, 1375, 60 USPQ2d 1272 (Fed. Cir. 2001).

As indicated by the attached Declaration, paragraph 8, *inter alia*, one skilled in the art would be capable of understanding the bounds of the claim when in read in light of the specification. Thus, claims 1-6, 8, and 10-14 particularly point out and distinctly claim the subject matter regarding as the invention.

Applicant respectfully requests the Examiner withdraw the rejection of claims 1-6, 8, and 10-14 under § 112, second paragraph.

III. 35 U.S.C. § 101: Claims 1-6, 8, 10-14

Claims 1-6, 8, and 10-14 were rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter.

Claims which recite a computerized method which includes a step of outputting information from a computer are tied to a particular machine or apparatus. *Ex Parte Dickerson*, (BPAI July 9, 2009). See also *In re Bilski*, 545 F.3d 943, 954 (Fed. Cir. 2008).

Because claim 1 and claim 8 are computerized methods which include the step of outputting information from a computer, claim 1 and claim 8 are directed towards patent-eligible subject matter. Independent claim 1 has been amended to recite "a computerized method..." and to include the step of "submitting the framed response to the buying organization from the computer system." Independent claim 8 has been amended to recite "computerized" steps and to include the step of "outputting the value position from the computer system." Thus, claim 1 and claim 8, from which claims 2-6 and 10-12 depend from and further limit, are directed towards statutory subject matter.

Because claims 13 and 14 include significant 'solution activity' elements executed by a computer, claims 13 and 14 are directed towards statutory subject matter. On pages 6-7, the Examiner argues: "While each claim implies a tangible embodiment of the instructions executed by a computer, insignificant extra-solution activity such as data gathering or outputting by a machine is claimed." Applicant respectfully disagrees. It is unclear which elements the Examiner believes are "extra-solution activity." In fact, most elements of claims 13 and 14 are operated by a computer program executable on a computer. All or most of the elements of the claims cannot be considered "extra solution activity." Thus, claims 13 and 14 comprise tangible embodiments executed by a computer.

Applicant respectfully requests the Examiner withdraw the rejection of claims 1-6, 8, and 10-14 under § 101.

CONCLUSION

In light of the amendments and remarks herein, Applicant respectfully requests allowance of all pending claims. A fee for a three month extension of time is due with this application. It is believed that no other fees are due with this submission. Should that determination be incorrect, then please debit Account No. 50-0548 and notify the undersigned.

Respectfully submitted,

11/12/09
Date

Christopher W. Bosken
Christopher W. Bosken
Registration No. 58,887
Attorney for Applicant

Berenato & White, LLC
6550 Rock Spring Drive, Suite 240
Bethesda, Maryland 20817
Telephone: (301) 896-0600
Facsimile: (301) 896-0607